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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,311	06/25/2001	Marta Blumenfeld	46.US2.PCT	2795

27206 7590 01/29/2003

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EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
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1634

11

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/762,311	Applicant(s) BLUMENFELD ET AL.	
	Examiner Carla Myers	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 42-63 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1634

***Election/Restriction***

1. Applicants election of group I and biallelic marker 9494 in Paper No. 10 is acknowledged. However, the previous restriction requirement is withdrawn and a new restriction requirement is set forth below.
2. Restriction is required under 35 U.S.C. § 121 and 372.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this office action, to elect a single invention to which the claims must be restricted.

Group I, claims 42-56 and 59, drawn to a composition comprising a polynucleotide.

Group II, claim 57, drawn to a composition comprising a polypeptide.

Group III, claim 58, drawn to a composition comprising an antibody.

Group IV, claims 60-63, drawn to a method for genotyping by determining the identity of a polymorphic base at a TBC-1 biallelic marker.

3. A 371 application is considered to have unity of invention only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. In the instant application, the linking technical feature of a TBC-1 nucleic acid does not provide a special technical feature over the prior art because Zon (U.S. Patent No. 5,700,927) teaches a TBC-1 gene and uses thereof. Since the inventions do not contribute a special technical feature when viewed over the prior art, they do not share a single inventive concept and lack unity

Art Unit: 1634

of invention. Additionally, Groups I, II and III are drawn to molecules which are functionally and structurally distinct from one another and do not share a common technical feature.

4. This application contains claims directed to more than one species of the generic invention .

These species are deemed to lack unity of invention because they are not so linked as to form a single general concept under PCT Rule 13.1. The species are as follows:

- A. Biallelic marker at position 9494 of SEQ ID NO: 1.
- B. Biallelic marker at position 1443 of SEQ ID NO: 2.
- C. Biallelic marker at position 5247 of SEQ ID NO: 2.
- D. Biallelic marker at position 6223 of SEQ ID NO: 2.
- E. Biallelic marker at position 14723 of SEQ ID NO: 2.
- F. Biallelic marker at position 19186 of SEQ ID NO: 2.
- G. Biallelic marker at position 18997 of SEQ ID NO: 2.
- H. Biallelic marker at position 18981 of SEQ ID NO: 2.
- I. Biallelic marker at position 29617 of SEQ ID NO: 2.
- J. Biallelic marker at position 42519 of SEQ ID NO: 2.
- K. Biallelic marker at position 69324 of SEQ ID NO: 2.
- L. Biallelic marker at position 69181 of SEQ ID NO: 2.
- M. Biallelic marker at position 69146 of SEQ ID NO: 2.
- N. Biallelic marker at position 76458 of SEQ ID NO: 2.
- O. Biallelic marker at position 78595 of SEQ ID NO: 2.

Art Unit: 1634

P. Biallelic marker at position 82159 of SEQ ID NO: 2.

Q. Biallelic marker at position 84522 of SEQ ID NO: 2.

R. Biallelic marker at position 84810 of SEQ ID NO: 2.

S. Biallelic marker at position 89967 of SEQ ID NO: 2.

5. Applicant is required in response to this action to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claims is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Accordingly, if applicant elects either group I or IV above, Applicant is required to elect a single species of biallelic marker selected from the group consisting of species A-S.

6. The species listed above do not relate to a single inventive concept under PCT Rule 13.2 because the species lack the same or corresponding special technical feature. Each of the claimed biallelic markers are considered to be structurally and functionally distinct from one another. Therefore, although the claimed polynucleotides share the feature of containing a biallelic marker,

Art Unit: 1634

the polynucleotides containing each of the distinct biallelic markers are not of the same nature and do not share a common structure.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. Papers related to this application may be faxed to Group 1634 via the PTO Fax Center using the fax number (703)-872-9306 or (703)-872-9307 (after final).

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

January 23, 2003

  
CARLA J. MYERS  
PRIMARY EXAMINER